



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,173	07/28/2000	Larry Y.L. Mo	15-UL-5310	2991

7590 12/02/2004

Dennis M. Flaherty, Esq.
Ostrager Chong Flaherty & Broitman P. C.
250 Park Avenue, 8th Floor
New York, NY 10177-0899

EXAMINER

NGUYEN, NHON D

ART UNIT PAPER NUMBER

2179

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/628,173	MO ET AL.	
	Examiner	Art Unit	
	Nhon (Gary) D Nguyen	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to amendment filed 06/15/2004.
2. Claims 1-32 are pending in this application. Claims 1, 14, 19, 25 and 29 are independent claims. In the amendment, no claim is canceled, no claim is amended, and no claim is added.

This action is made final.

Response to Amendment

Response to Declaration under 37 C.F.R. 1.131

3. The DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. 1.131 filed on 06/15/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Nagarajan reference.

The DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. 1.131 attempts to show conception of the invention prior to the effective date of the reference 02/28/2000 of the application (constructive reduction to practice).

I. Who May Make Affidavit or Declaration

The Declaration filed on 06/15/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Nagarajan reference (U.S. Patent No. 6,665,098 B1).

The following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.

Art Unit: 2179

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

In this case, required by the law that inventors Larry Y.L. Mo and Terry J. Duesterhoeft have to sign on the Declaration.

II. Conception

(A) A conception of an invention, through evidenced by disclosure, drawing, and even a model, is not a complete invention under the patent laws, and confers no rights on inventor, and has no effect on a subsequently granted patent to another, **UNLESS THE INVENTORS FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT.**

(B) General allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23.23 O.G. 1224 (Comm'r Pat. 183). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

(C) The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere

Art Unit: 2179

pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974).

Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964).

When reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and “notes.” However, in the affidavits the applicant recited “I believe that the Invention Disclosure Sheet annexed hereto (Exhibit A) shows that the broad concept was conceived as early as August 27, 1999” which only indicated a vague idea of conception is made on August 27, 1999. The requirement for the conception is more than a vague idea of how to show the problem; the means themselves and their interaction must be comprehended also. The applicant also must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by application. The statement which recited in paragraph 3 is general allegation that the invention was complete prior to the date of the reference 02/28/2000 without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.II.

(III) Diligence

(A) In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly

Art Unit: 2179

establish, since diligence come into question only after prior conception is establish. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958).

(B) The critical period in which diligence must be shown begins just prior to the effective date of the reference 02/28/2000 or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).

(C) The conception occurs prior to the date of the reference, but reduction to practice afterward, it is not enough merely to allege that applicant or patent owner had been diligence. The exhibit(s) which was demonstrated by the application was not clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the filing date 07/28/2000 in determining the sufficiency of 37 CFR 1.131, the critical period in which diligence must be shown begin just prior to the effective date of the reference 02/28/2000 or activity ends with the date of a reduction to practice, either actual or constructive.

(IV) Claims or Claims limitation is not comprehended by the exhibits.

Exhibit A does not explicitly and adequately establish conception of the claim invention.

Nowhere in the Exhibit A mentions “monitoring the state of said control input devices, during a predetermined time period, to detect a change in state of a control input device that results in said image processing system generating a changed value of said first image processing parameter different than said stored value of said first image processing parameter” as recited in claim 1. Claims do not appear to be supported by the evidence provided in claim. It means that there is not enough evidence to clearly prove the relationships between the Exhibit A and the Claims.

4. The DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. 1.131 filed on 06/15/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Nagarajan reference as pointed out above; Therefore, claims 1-32 remain rejected.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 9, 14-16, 19-22, 25, 26, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagarajan (US 6,665,098).

As per independent claim 1, Nagarajan teaches an imaging system comprising:

a display monitor (col. 4, line 53);

an operator interface comprising a multiplicity of control input devices for setting respective image processing parameters (col. 3, lines 8-10);

a scanning subsystem for acquiring raw data (col. 2, line 66 – col. 3, line 5); and

an image processing system for processing acquired raw data to display an image frame of imaging data on said display monitor (col. 2, line 66 – col. 3, line 5), said image processing system comprising memory for storing values of image processing parameters (col. 2, lines 25-26) and a computer programmed to perform the following steps:

controlling said display monitor to display a first image frame of imaging data processed in accordance with values of first and second image processing parameters stored in said memory prior to display of said first image frame (col. 4, line 62 – col. 5, line 30);

monitoring the state of said control input devices, during a predetermined time period, to detect a change in state of a control input device that results in said image processing system generating a changed value of said first image processing parameter different than said stored value of said first image processing parameter (col. 5, lines 31-44);

controlling said display monitor to display a second image frame of imaging data processed in accordance with said changed value of said first image processing parameter, said first and second image frames being based on the same acquired raw data; and storing said changed value of said first image processing parameter in said memory (col. 3, lines 16-34).

As per claims 2 and 3, which are dependent on claim 1 and 2, respectively, Nagarajan teaches the control input device having said changed state controls the value of said second image processing parameter and wherein the contrast in said displayed image frames is a function of at least said first and second image processing parameters (col. 3, lines 12-15).

As per claim 4, which is dependent on claim 1, Nagarajan teaches the first image processing parameter is a gray scale level (col. 5, line 66 – col. 6, line 23).

As per claims 5 and 6, which are both dependent on claim 4, since Nagarajan's system is an image processing system with gray scales to handle pixel gray image (col. 5, line 66 – col. 6,

Art Unit: 2179

line 23), a gray map must be in present to store values of the gray-scale level. Therefore, it is inherent in Nagarajan's system that the computer is further programmed to generate a gray map as a function of a stored changed value of said gray-scale level and the computer is further programmed to generate a gray map as a function of an average of a multiplicity of stored changed values of said gray-scale level.

As per claim 9, which is dependent on claim 3, Nagarajan teaches the first image processing parameter is a gray scale level and said second image processing parameter is gray map selection (col. 5, line 66 – col. 6, line 23).

As per independent claim 14, it is rejected under the same rationale as claim 1.

As per claim 15, which is dependent on claim 14, Nagarajan teaches the new value of said first image processing parameter is an average of a plurality of values, said plurality including at least said changed value of said first image processing parameter and said stored value of said first image processing parameter (col. 3, lines 16-34).

As per claim 16, which is dependent on claim 14, it is a similar scope to claim 2; therefore, it should be rejected under the same rationale.

As per independent claim 19, it is a similar scope to claim 1; therefore, it should be rejected under the same rationale.

As per claim 20, which is dependent on claim 19, it is a similar scope to claim 2; therefore, it should be rejected under the same rationale.

As per claim 21, which is dependent on claim 20, it is a similar scope to claim 3; therefore, it should be rejected under the same rationale.

As per claim 22, which is dependent on claim 21, it is a similar scope to claim 5; therefore, it should be rejected under the same rationale.

As per independent claim 25, it is rejected under the same rationale as claim 1.

As per claim 26, which is dependent on claim 25, it is a similar scope to claim 2; therefore, it should be rejected under the same rationale.

As per independent claim 29, it is rejected under the same rationale as claim 1.

As per claim 30, which is dependent on claim 29, it is a similar scope to claim 2; therefore, it should be rejected under the same rationale.

Claim Rejections - 35 USC § 103

Art Unit: 2179

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 8, 17, 23, 27, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagarajan in view of Jensen et al. ("Jensen", US 6,175,614).

As per claims 7 and 8, which are both dependent on claims 3, Nagarajan teaches the first image processing parameter is a gray scale level (col. 5, line 66 – col. 6, line 23); however, Nagarajan does not disclose the second image processing parameter is dynamic range and gain. Jensen discloses a gray scale range is optimized by to assure a correct gain and a proper dynamic range (col. 2, lines 6-15 and col. 5, lines 25-30). It would have been obvious to an artisan at the time of the invention to use the teaching from Jensen of including dynamic range and gain as the second image processing parameter in Nagarajan's system since it would optimize the gray scale range.

As per claim 17, which is dependent on claim 16, Nagarajan teaches the first image processing parameter is a gray scale level and said second image processing parameter is gray map selection (col. 5, line 66 – col. 6, line 23). Nagarajan, however, does not disclose the second image processing parameter is taken from the group consisting of dynamic range and gain. Jensen discloses a gray scale range is optimized by to assure a correct gain and a proper dynamic range (col. 2, lines 6-15 and col. 5, lines 25-30). It would have been obvious to an artisan at the time of the invention to use the teaching from Jensen of including dynamic range and gain as the

Art Unit: 2179

second image processing parameter in Nagarajan's system since it would optimize the gray scale range.

As per claim 23, which is dependent on claim 21, it is a similar scope to claim 17; therefore, it should be rejected under the same rationale.

As per claim 27, which is dependent on claim 26, it is a similar scope to claim 17; therefore, it should be rejected under the same rationale.

As per claim 31, which is dependent on claim 30, it is a similar scope to claim 17; therefore, it should be rejected under the same rationale.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagarajan in view of Jacobi et al. ("Jacobi", US 4,271,389).

As per claim 10, which is dependent on claim 4, Nagarajan does not disclose the changing step comprises the steps of generating and analyzing a pixel intensity histogram of the imaging data in said second image frame. Jacobi discloses an expanded pixel histogram is generated and analyzed (col. 8, lines 36-47). It would have been obvious to an artisan at the time of the invention to use the teaching from Jacobi of generating and analyzing a pixel histogram in Nagarajan's system since it would determine an appropriate mapping function for the selected pixel data.

6. Claims 11, 12, 18, 24, 28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagarajan in view of Hull et al. ("Hull", US 6,665,086).

As per claim 11, which is dependent on claim 1, Nagarajan does not disclose the computer is further programmed to store said changed value of said first image processing parameter in association with a system user ID inputted via said operator interface. Hull discloses that at col. 4, lines 34-41. It would have been obvious to an artisan at the time of the invention to use the teaching from Hull of storing the changed value of image processing parameter in association with a system user ID inputted via said operator interface in Nagarajan's system since it would allow the system to keep track of the changing records.

As per claim 12, which is dependent on claim 11, modified Nagarajan does not disclose the computer is further programmed to store an application type or exam type in association with said changed value of said first image processing parameter and said system user ID. Hull discloses that at col. 4, lines 42-57. It would have been obvious to an artisan at the time of the invention to use the teaching from Hull of storing an application type or exam type in association with said changed value of said first image processing parameter and said system user ID in modified Nagarajan's system since it would allow the system to keep track of the changing records.

As per claim 18, which is dependent on claim 14, it is a similar scope to claim 11; therefore, it should be rejected under the same rationale.

Art Unit: 2179

As per claim 24, which is dependent on claim 19, it is a similar scope to claim 11; therefore, it should be rejected under the same rationale.

As per claim 28, which is dependent on claim 25, it is a similar scope to claim 11; therefore, it should be rejected under the same rationale.

As per claim 32, which is dependent on claim 29, it is a similar scope to claim 11; therefore, it should be rejected under the same rationale.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagarajan in view of Hull et al. ("Hull", US 6,665,086).

As per claim 13, which is dependent on claim 11, modified Nagarajan does not disclose the computer is further programmed to control said display monitor to display a message, prior to said storing step, requesting confirmation from the system user that said changed value of said first image processing parameter should be stored. Examiner takes Official Notice that displaying a confirming message before changing a parameter value is well known in computer art. It would have been obvious to an artisan at the time of the invention to add a confirming message before changing a parameter value in modified Nagarajan's system since it would prevent the user from inadvertently modifying to the image processing parameters.

Conclusion

Art Unit: 2179

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Inquiries

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D Nguyen whose telephone number is (571)272-4139. The examiner can normally be reached on Monday - Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571)272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2179

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nhon (Gary) Nguyen
November 18, 2004


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100